

REMARKS/ARGUMENTS

Claims 1-51 are pending in the present application. The Office Action mailed March 9, 2006 rejected claims 1-3, 6-20 and 23-51 under 35 U.S.C. § 102(b). The Office Action rejected claims 4, 5, 21 and 22 under 35 U.S.C. § 103(a).

Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

A. Claims 1-3, 6-20 and 23-51 Rejected Under 35 U.S.C. § 102(b)

The Office Action rejected claims 1-3, 6-20 and 23-51 under 35 U.S.C. § 102(b) as being anticipated by U.S. Publication No. 2001/0037248 to Klein (hereinafter, "Klein"). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Applicants respectfully submit that the claims at issue are patentably distinct from Klein. Klein does not disclose all of the limitations in these claims.

Claim 1 is directed to a method that is implemented by an identification tag reader. Claim 1 recites:

reading a first identification tag that comprises an instruction to form a logical connection with a computing device;
using address information associated with the computing device to form the logical connection with the computing device in accordance with the instruction;

obtaining data; and

transmitting the data to the computing device via the logical connection.

Klein relates generally to “a method for obtaining warranty registration of products, facilitating return of lost products, and expediting warranty service on defective products.” Klein, paragraph [0013]. Klein discloses “providing a unique identifier on or within each product.” Id. The unique identifier is “supplied in an RFID, which is embedded in the label” on the product. Id., paragraph [0016]. A person who finds a lost article “will deliver the product to a return location where a return agent can automatically access the unique identifier, preferably by use of an RFID reader apparatus and accessing an online database, thereby facilitating identification of the owner and owner address whereupon the lost product can be returned by the return agent.” Id., paragraph [0015].

The Office Action asserts that “Klein discloses a RFID label (tag) that contains printed information and electronically stored and transmittable information [0023][0024].” Office Action, page 3, paragraph 3. The Office Action further asserts that “the information may include address information [0024], which inherently includes port information.” Id. The Office Action also asserts:

Applicant argues that Klein does not disclose the instruction to form a logical connection with the computing device. The examiner respectfully disagrees. As seen above, it is inherent that Klein’s information includes an address. The examiner asserts that this address is seen by the machine as a series of logical bits (i.e. “1s” and “0s”). This address is used to “communicate” and connect in a logical manner with the computing device.

Office Action, page 3, paragraph 7.

These assertions in the Office Action do not address the specific language that is recited in claim 1. As mentioned, the Office Action asserts that “an address” mentioned in Klein “is used to ‘communicate’ and connect in a logical manner.” Id. However, Applicants are unsure about the relevance of this assertion. The statement “‘communicate’ and connect in a logical manner” does not appear in claim 1. Instead, claim 1 recites that the identification tag “comprises an instruction to form a logical connection with a computing device.” Thus, the relevant issue is whether there is anything in Klein that discloses “an instruction to form a logical connection with a computing

device.” Unfortunately, the Office Action does not clearly indicate what portion of Klein is being asserted as the “instruction” recited in claim 1.

Klein states the following:

[T]he purchaser who provides warranty registration data ... receives a bonus in the form of registration under a lost product return service wherein instructions on the product (usually in a label) offer a reward to any person who finds the product if it becomes lost and returns it to a designated return location. ... A preferred service can be identified, e.g., Federal Express, U.S. Postal Service, UPS, commercial airline or a competitive service. ... The owner is identified by the service by communicating the unique product identification information, preferably automatically by reading embedded RFID information or a bar code in or on the label itself, and communicating it to a central location such as by computer assisted communication to a central computer server.

Klein, paragraph [0020] (emphasis added). Thus, Klein discloses that a mail delivery service (e.g., Federal Express) may identify the owner of a product by “reading embedded RFID information” in a label that is attached to the product and “communicating it to a ... central computer server.” Id.

Certainly Klein does not explicitly disclose that the RFID label comprises an “instruction to form a logical connection with a computing device.” Klein states that a “typical RFID label carries a unique customer ID number embedded in a computer chip.” Klein, paragraph [0025]. Klein also discloses that an RFID label may include “product identification information.” Id., paragraph [0020]. However, neither a unique customer ID number nor product identification information is “an instruction to form a logical connection with a computing device,” as required by claim 1.

Nor does Klein inherently disclose that the RFID label comprises an “instruction to form a logical connection with a computing device.” Although M.P.E.P. § 2112 states “inherent disclosures of a prior art reference may be relied upon in the rejection of claims,” the Federal Circuit requires that examiners “‘make clear that the missing descriptive matter is necessarily present in the thing described in the reference.’” Dayco Prods., Inc. v. Total Containment, Inc., 329 F.3d 1358, 1369 66 U.S.P.Q.2d (BNA) 1801 (Fed. Cir. 2003) (quoting Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268 20 U.S.P.Q.2d (BNA) 1746 (Fed. Cir. 1991)). The M.P.E.P. further requires that the

examiner ““provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”” M.P.E.P. § 2112 (quoting Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)).

It is certainly not the case that the RFID label in Klein “necessarily” includes an instruction to form a logical connection with the central computer server. In Klein, it appears that the main purpose of the RFID label on the product is to provide the unique product ID, which is then used to determine the owner of the product. This functionality is not “necessarily” a part of connecting to the central computer server. Even if the RFID reader used by the mail delivery service connects to the central computer server at some point, there are many ways that the RFID reader in Klein could receive an instruction to connect to the central computer server other than from reading the RFID label. For example, the user of the RFID reader could provide the instruction to connect to the central computer server. Alternatively, software running on the RFID reader, or on another computer that is attached to the RFID reader, could provide the instruction to connect to the central computer server. There is nothing in Klein that supports the position that the disclosed RFID label “necessarily” includes an instruction to form a logical connection with the central computer server, as would be required to show inherency.

In view of the foregoing, Applicants respectfully submit that claim 1 is patentably distinct from Klein. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn.

Claims 2-3 and 6-17 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn for at least the same reasons as those presented above in connection with claim 1.

Claim 18 is directed to an identification tag reader. The identification tag reader includes a processor, memory in electronic communication with the processor, and instructions stored in the memory. The instructions are executable by the processor to implement a method that comprises:

reading a first identification tag that comprises an instruction to form a logical connection with a computing device;

using address information associated with the computing device to form the logical connection with the computing device in accordance with the instruction;

obtaining data; and

transmitting the data to the computing device via the logical connection.

As discussed above, Klein does not disclose “reading a first identification tag that comprises an instruction to form a logical connection with a computing device,” as recited in claim 18. Accordingly, Applicants respectfully request that the rejection of claim 18 be withdrawn.

Claims 19-20 and 23-34 depend either directly or indirectly from claim 18. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn for at least the same reasons as those presented above in connection with claim 18.

Claim 35 is directed to a method that is implemented by an identification tag reader. The claimed method comprises:

reading a first identification tag that comprises an instruction to form a logical connection with a computing device and to send subsequently read data to the computing device via the logical connection, wherein the first identification tag also comprises address information associated with the computing device;

using the address information to form the logical connection with the computing device in accordance with the instruction;

reading a second identification tag that comprises data; and

transmitting the data to the computing device via the logical connection.

As discussed above, Klein does not disclose “reading a first identification tag that comprises an instruction to form a logical connection with a computing device,” as recited in claim 35. Accordingly, Applicants respectfully request that the rejection of claim 35 be withdrawn.

Claims 36-39 depend either directly or indirectly from claim 35. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn for at least the same reasons as those presented above in connection with claim 35.

Claim 40 is directed to an identification tag reader. The identification tag reader includes a processor, memory in electronic communication with the processor, and instructions stored in the memory. The instructions are executable by the processor to implement a method that comprises:

- reading an identification tag that comprises an instruction to form a logical connection with a computing device;

- determining whether a link key database includes a link key associated with the computing device;

- if the link key database includes the link key, establishing a logical connection with the computing device using address information associated with the computing device and the link key;

- if the link key database does not include the link key:

- establishing a logical connection with the computing device using address information associated with the computing device, wherein the computing device enters a PIN for authentication, and wherein the link key is generated; and

- storing the link key in the link key database;

- obtaining data; and

- transmitting the data to the computing device via the logical connection.

As discussed above, Klein does not disclose “reading an identification tag that comprises an instruction to form a logical connection with a computing device,” as recited in claim 40. Accordingly, Applicants respectfully request that the rejection of claim 40 be withdrawn.

Claims 41-45 depend either directly or indirectly from claim 40. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn for at least the same reasons as those presented above in connection with claim 40.

Claim 46 is directed to a method that is implemented by an identification tag reader. The claimed method comprises:

- reading an identification tag that comprises an instruction to form a logical connection with a computing device;

- determining whether a link key database includes a link key associated with the computing device;

if the link key database includes the link key, establishing a logical connection with the computing device using address information associated with the computing device and the link key;

if the link key database does not include the link key:

establishing a logical connection with the computing device using address information associated with the computing device, wherein the computing device enters a PIN for authentication, and wherein the link key is generated; and

storing the link key in the link key database;

obtaining data; and

transmitting the data to the computing device via the logical connection.

As discussed above, Klein does not disclose "reading an identification tag that comprises an instruction to form a logical connection with a computing device," as recited in claim 46. Accordingly, Applicants respectfully request that the rejection of claim 46 be withdrawn.

Claims 47-51 depend either directly or indirectly from claim 46. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn for at least the same reasons as those presented above in connection with claim 46.

C. Rejection of Claims 4, 5, 21 and 22 Under 35 U.S.C. § 103(a)

The Office Action rejected claims 4, 5, 21 and 22 under 35 U.S.C. § 103(a) based on Klein. This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the

desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claims at issue are patentably distinct from Klein. Klein does not teach or suggest all of the limitations in these claims.

Claims 4 and 5 depend from claim 1. As discussed above, Klein does not teach or suggest “reading a first identification tag that comprises an instruction to form a logical connection with a computing device,” as recited in claim 1. Accordingly, Applicants respectfully request that the rejection of claims 4 and 5 be withdrawn.

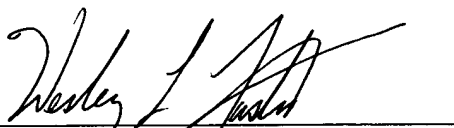
Claims 21 and 22 depend from claim 18. As discussed above, Klein does not teach or suggest “reading a first identification tag that comprises an instruction to form a logical connection with a computing device,” as recited in claim 18. Accordingly, Applicants respectfully request that the rejection of claims 21 and 22 be withdrawn.

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Amdt. dated June 9, 2006
Reply to Office Action of March 9, 2006

D. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Wesley L. Austin', is written over a horizontal line.

Wesley L. Austin
Reg. No. 42,273
Attorney for Applicant

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MADSON & AUSTIN
Gateway Tower West
15 West South Temple, Suite 900
Salt Lake City, Utah 84101
Telephone: 801/537-1700